

**EXHS**

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JOSE JOVEL

(Name)

01-03-03

(Date)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

PUBLICATIONS INTERNATIONAL, LTD., )

Opposer, )

v. )

LEAPFROG ENTERPRISES, INC., )

Applicant. )

Opposition No. 91153776

Serial No. 75/764,192

**MOTION FOR SUSPENSION OF OPPOSITION**

Pursuant to C.F.R. §2.117(a), Applicant LeapFrog Enterprises, Inc. ("Applicant") hereby moves the Board for an order suspending all proceedings in this matter, pending the termination of a civil action in federal court between the parties to this Opposition.

On or about May 25, 2001, Opposer Publications International, Ltd. ("Opposer") filed suit against Applicant (under the name Knowledge Kids Enterprises, Inc., Applicant's former name) in federal court for trademark infringement and related causes of action. The lawsuit concerns the mark which is the subject of the herein opposed application (LEAPFROG SCHOOLHOUSE), as well as other of Applicant's marks (collectively "the Marks"). True and correct copies of Opposer's complaint and amended complaint, filed in the United States District

Court for the Northern District of Illinois, Case No. 01-C-3876, are attached hereto as Exhibit A. Applicant answered the complaint and counter-claimed against Opposer for trademark infringement (and other causes of action). True and correct copies of Applicant's answer and counterclaims are attached hereto as Exhibit B.

In its complaint, Opposer alleges, *inter alia*, that the Marks are likely to be confused with Opposer's mark, and seeks to establish the priority of Opposer's mark over the Marks – the same issues raised in this Opposition proceeding. Accordingly, the federal court proceedings will be dispositive of the issues in this Opposition. For these reasons, Applicant respectfully seeks an order from the Board suspending these proceedings until termination of the pending action filed in the United States District Court for the Northern District of Illinois. See Trademark Trial and Appeal Board Manual of Procedure, §510.02(a).

Applicant also notes that Applicant and Opposer are both parties to the following five Oppositions, involving the related marks:

- Opposition No. 91151449 (LEAP FROG and Design, Serial No. 76/260,798), for which a similar Motion to Suspend was granted. This Opposition is consolidated with and parent to Opposition Nos. 91152182 and 91152514;
- Opposition No. 91152182 (LEAPFROG SCHOOLHOUSE, Serial No. 76/175,391), for which a similar Motion to Suspend was granted. This Opposition is consolidated with and child to Opposition No. 91151449; and
- Opposition No. 91152514 (LEAPFROG SCHOOLHOUSE, Serial No. 76/175,320), for which a similar Motion to Suspend was granted. This Opposition is also consolidated with and child to Opposition No. 91151449.

*The above three oppositions were consolidated and suspended on October 1, 2002. See October 1, 2002 order of Andrew Baxley, attached hereto as Exhibit C.*

- Opposition 91152977 (LEAPFROG LEARNING POND, Serial No. 76/197,256), for which a similar Motion to Suspend was granted December 17, 2002, attached hereto as Exhibit D.

- Opposition No. 91153466 (LEAP'S POND, Serial No. 76/213,319), for which a similar Motion to Suspend is currently pending. Applicant's request, filed December 3, 2002, is attached hereto as Exhibit E.

Respectfully submitted,

Date: January 3, 2003

By: 


Kathryn M. Wheble, Esq.  
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One Maritime Plaza, 20th Floor  
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Telephone: (415) 693-2000  
Attorney for LeapFrog Enterprises, Inc.

**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing Motion for Suspension of Opposition was mailed, first class, postage paid, to counsel for Opposer:

Margaret Ferguson, Esq.  
Kelley Drye & Warren LLP  
101 Park Avenue  
New York, New York 10178

Date: January 3, 2003

  
Name: \_\_\_\_\_

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January 3, 2003

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01-03-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #10

**Re: Motion for Suspension of Opposition  
Publications International, Ltd., v. LeapFrog Enterprises, Inc.  
Opposition No. 91153776  
Our reference: LeapFrog Enterprises, Inc./Dispute with Publications International,  
Ltd. (LEAPFROG SCHOOLHOUSE, Class 28)**

Dear Sir/Madam:

We enclose a Motion for Suspension of Opposition in the matter referenced above. Please confirm receipt of this document by date stamping and returning the enclosed postcard.

Thank you for your assistance. Please do not hesitate to contact me if you have any questions.

Very truly yours,

COOLEY GODWARD LLP

  
Kathryn M. Wheble

Enclosures

cc: Margaret Ferguson, Esq., Kelley Drye & Warren LLP (w/ encl.)  
Tsan Abrahamson, Esq. (w/ encl./m)  
John W. Crittenden, Esq. (w/ encl./m)

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